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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,518	06/05/2006	Rupert Katritzky	7675P001	6077

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP  
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EXAMINER
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MCCLELLAND, KIMBERLY KEIL

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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12/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,518	<b>Applicant(s)</b> KATRITZKY ET AL.	
	<b>Examiner</b> KIMBERLY K. MCCLELLAND	<b>Art Unit</b> 1791	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/16/06.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 74-128 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1 and 74-128 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 and 74-82, drawn to an automated pharmaceutical dispensing system. No special technical feature exists for Group I, because all the limitations of independent claim 1 can be found in the prior art. U.S. Patent Application Publication No. 2002/0099467 to Sleep et al. discloses means for selecting and retrieving a pharmaceutical pack, said means being arranged to deliver said pack to a labeling station, wherein said labeling station comprises a label printer arranged to print a label comprising information specific to a patient for whom said pharmaceutical pack is intended, and means for applying said label to said pack; the system further comprising means for delivering said pack from the labeling station so as to be accessible to a user, wherein the means for applying the label is adapted to alter the way in which the label is applied depending upon the dimensions of the pack to be labeled (See Paragraphs 0049, 0063, and 0066).

Group II, claim(s) 82-83, drawn to a labeling station. No special technical feature exists for Group II, because all the limitations of independent claim 82 can be found in the prior art. U.S. Patent Application Publication No. 2002/0099467 to Sleep et al. discloses means for selecting and retrieving a pharmaceutical pack, said means being arranged to deliver said pack to a labeling station, wherein said labeling station comprises a label printer arranged to print a label comprising information specific to a patient for whom said pharmaceutical pack is intended, and means for applying said label to said pack; the system further comprising means for delivering said pack from the labeling station so as to be accessible to a user, wherein the means for applying the label is adapted to alter the way in which the label is applied depending upon the dimensions of the pack to be labeled (See Paragraphs 0049, 0063, and 0066).

Group III, claim(s) 84-86, drawn to a computer software product. No special technical feature exists for Group III, because all the limitations of independent claim 84 can be found in the prior art. U.S. Patent Application Publication No. 2002/0099467 to Sleep et

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al. discloses means for processing a plurality of orders, each order comprising at least one piece of patient-specific information and a required drug, means for accessing a database referenced to said required drug for determining at least one dimension of a pack in which the drug is packaged, means for determining how to apply a label to said pack dependent on said pack dimension and means for giving instructions to a labeling station, said instructions including said patient-specific information and an instruction for determining how a label applicator is to apply a label to a pack (See Paragraphs 0049, 0063, 0066, 0157-0161, and 0184).

Group IV, claim(s) 87, drawn to a software for execution on a server. No special technical feature exists for Group IV, because all the limitations of independent claim 87 can be found in the prior art. U.S. Patent Application Publication No. 2002/0099467 to Sleep et al. discloses means for receiving an order, said order comprising at least one piece of patient-specific information and a required drug, means for interrogating a database referenced to said required drug and for receiving therefrom a determination relating to at least one dimension of a pack in which the drug is packaged, and means for giving instructions to a labeling station, said instructions including said patient-specific information and information or instructions based on said pack dimension determination for determining how to apply a label to said pack (See Paragraphs 0049, 0063, 0066, 0157-0161, and 0184).

Group V, claim(s) 88, drawn to a computer software product. No special technical feature exists for Group V, because all the limitations of independent claim 88 can be found in the prior art. U.S. Patent Application Publication No. 2002/0099467 to Sleep et al. discloses means, to receive a message indicating delivery of a pack to be labeled to a labeling station and to transmit a message to said labeling station for applying a label to said pack such that said software is able to coordinate the delivery of said pack and the application of a particular label thereto (See Paragraphs 0049, 0063, and 0066).

Group VI, claim(s) 89-96, drawn to a method of operating an automated pharmaceutical dispensing system. No special technical feature exists for Group VI, because all the limitations of independent claim 89 can be found in the prior art. U.S. Patent Application Publication No. 2002/0099467 to Sleep et al. discloses selecting and retrieving a pharmaceutical pack, delivering said pack to a labeling station, printing a label comprising information specific to a patient for whom said pharmaceutical pack is intended, applying said label to said pack; and delivering said pack from the labeling station so as to be accessible to a user; further comprising altering the way in which the label is applied depending upon the dimensions of the pack being labeled (See Paragraphs 0049, 0063, and 0066).

Group VII, claim(s) 97, drawn to a method of automatically labeling. No special technical feature exists for Group VII, because all the limitations of independent claim 97 can be found in the prior art. U.S. Patent Application Publication No. 2002/0099467 to Sleep et al. discloses processing a plurality of orders, each order comprising at least one piece

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of patient-specific information and a required drug, accessing a database referenced to said required drug for determining at least one dimension of a pack in which the drug is packaged, determining how to apply a label to said pack dependent on said pack dimension and giving instructions to a labeling station, said instructions including said patient-specific information and an instruction for determining how a label applicator is to apply a label to a pack (See Paragraphs 0049, 0063, 0066, 0157-0161, and 0184).

Group VIII, claim(s) 98-106, drawn to an automated pharmaceutical dispensing system. No special technical feature exists for Group VIII, because all the limitations of independent claim 98 can be found in the prior art. U.S. Patent Application Publication No. 2002/0099467 to Sleep et al. discloses a selecting and retrieving subsystem for selecting and retrieving a pharmaceutical pack, said selecting and retrieving subsystem being arranged to deliver said pack to a labeling station, said labeling station comprising: a label printer arranged to print a label comprising information specific to a patient for whom said pharmaceutical pack is intended; and a label applicator subsystem for applying said label to said pack; the system further comprising a delivery subsystem for delivering said pack from the labeling station to a user-accessible point; wherein the label applicator subsystem is adapted to alter the way in which the label is applied depending upon a dimension of the pack to be labeled (See Paragraphs 0049, 0063, and 0066).

Group IX, claim(s) 107-114, drawn to a stock retrieval labeling system. No special technical feature exists for Group IX, because all the limitations of independent claim 107 can be found in the prior art. U.S. Patent Application Publication No. 2002/0099467 to Sleep et al. discloses a retrieval subsystem for retrieving an item of stock in accordance with an order therefor; a label printer for printing a label for said item with information specific to said order; a label applicator for applying said label to said item; and a control subsystem in data communication with said retrieval subsystem and said label applicator subsystem, said control subsystem being arranged to coordinate retrieval of said item and application of said label thereto; wherein the label applicator is adapted to alter the way in which the label is applied depending upon a dimension of the pack to be labeled (See Paragraphs 0049, 0063, 0066, 0157-0161, and 0184).

Group X, claim(s) 115-116, drawn to a labeling station. No special technical feature exists for Group X, because all the limitations of independent claim 115 can be found in the prior art. U.S. Patent Application Publication No. 2002/0099467 to Sleep et al. discloses a dimension determination subsystem for determining at least one dimension of a pack to be labeled and a label applicator subsystem applying a label to a pack in an orientation dependent upon said determined dimension (See Paragraphs 0049, 0063, and 0066).

Group XI, claim(s) 117-119, drawn to a computer software product. No special technical feature exists for Group XI, because all the limitations of independent claim 117 can be found in the prior art. U.S. Patent Application Publication No. 2002/0099467 to Sleep et

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al. discloses logic for processing a plurality of orders, each order comprising at least one piece of patient-specific information and a required drug, logic for accessing a database referenced to said required drug for determining at least one dimension of a pack in which the drug is packaged, logic for determining how to apply a label to said pack dependent on said pack dimension and logic for giving instructions to a labeling station, said instructions including said patient-specific information and an instruction for determining how a label applicator is to apply a label to a pack (See Paragraphs 0049, 0063, 0066, 0157-0161, and 0184).

Group XII, claim(s) 120, drawn to a software for execution on a server. No special technical feature exists for Group XII, because all the limitations of independent claim 120 can be found in the prior art. U.S. Patent Application Publication No. 2002/0099467 to Sleep et al. discloses logic for receiving an order, said order comprising at least one piece of patient-specific information and a required drug, logic for interrogating a database referenced to said required drug and for receiving therefrom a determination relating to at least one dimension of a pack in which the drug is packaged, and logic for giving instructions to a labeling station, said instructions including said patient-specific information and information or instructions based on said pack dimension determination for determining how to apply a label to said pack (See Paragraphs 0049, 0063, 0066, 0157-0161, and 0184).

Group XIII, claim(s) 121-128, drawn to a method of operating an automated pharmaceutical dispensing system. No special technical feature exists for Group XIII, because all the limitations of independent claim 121 can be found in the prior art. U.S. Patent Application Publication No. 2002/0099467 to Sleep et al. discloses selecting and retrieving a pharmaceutical pack; delivering said pack to a labeling station, said labeling station comprising a label printer and a label applicator; said label printer printing a label comprising information specific to a patient for whom said pharmaceutical pack is intended; said label applicator applying said label to said pack; and delivering said pack from the labeling station to a user-accessible point; further comprising the step of altering the way in which the label is applied by the label applicator depending upon a dimension of the pack being labeled. (See Paragraphs 0049, 0063, 0066, 0157-0161, and 0184).

2. The inventions listed as Groups I-XIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: While all the above groups are linked by the concept of labeling, this concept is not novel, as seen in the

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cited references. Consequently, no common special technical feature has been identified linking the above distinctive groups, which indicates a lack of unity.

3. Due to the complexity of the above restriction requirement, a telephone call was not made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/  
Examiner, Art Unit 1791

KKM

/Philip C Tucker/  
Supervisory Patent Examiner, Art Unit 1791